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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES J. MILLER
and
FRANCIS E. CHARLEVILLE, IV.

Appeal 2008-2806
Application 10/730,431
Technology Center 3600

Oral Hearing Held: January 15, 2009

Before DEMETRA J. MILLS, RICHARD M. LEOVITZ, and
FRANCISCO C. PRATS, *Administrative Patent Judges*.

ON BEHALF OF THE APPELLANTS:

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The above-entitled matter came on for hearing on Thursday, January 15, 2009, commencing at 1:05 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Patricia A. Edwards, RPR, Notary Public.

PROCEEDINGS

MR. PAYNE: Let me say, going to kind of go fishing here. This is an interesting case. And first let me just say that this is kind of an interesting adventure because as simple and as straightforward as it is, it's really unique. And I think in looking at the prior art references, you're going to find out how unique it is.

Now, I have represented -- I have the drawings under tab 2, but let me, if I could -- this is what we have. Now, I'm going to give one of you -- each one of you one of these, but I want to tell you, if you cock it, it can --

JUDGE MILLS: Spring back?

MR. PAYNE: I had one in my finger last week, so I'm going to just show it to you so that you will be able to see exactly what we're talking about. It's illustrated in the drawings, but there's some magic about being able to see the real thing.

And just before we get going, just because I think it's informative, if I -- could I -- I don't -- can I approach just a little bit?

JUDGE MILLS: Oh, sure.

JUDGE LEBOVITZ: Sure.

MR. PAYNE: What I wanted to do is show you --

JUDGE LEBOVITZ: In the third position, we're pretty familiar with that.

MR. PAYNE: Exactly right. That is the third position. Okay. Then I don't have to talk quite as long as I thought I did.

JUDGE LEBOVITZ: No.

1 MR. PAYNE: Okay. When this thing is cocked, it looks like that
2 (indicating). And when it -- and this is why I say you need to be careful if
3 you do. When it comes out, it really comes out. So, you know, it's one of
4 those things.

5 And these are kind of just -- they're not professionally made, but
6 they're made -- this is exactly what the invention is. So as the force on both
7 sides hits it, it's really -- and if you've got your finger down here (indicating),
8 it's going to hook you.

9 So anyway, that's what we're talking about. Yes, sir, as we go through
10 the references, I wanted you to be sure to have the real thing.

11 Now, let me also show one other characteristic of this, which I think is
12 kind of interesting, and it's in the claims.

13 JUDGE LEBOVITZ: And I just want to note for the record that this
14 corresponds to one of the drawings.

15 MR. PAYNE: Absolutely.

16 JUDGE LEBOVITZ: I appreciate that.

17 MR. PAYNE: Actually, the first drawing or two is not the
18 embodiment that's in the claims. The claims were restricted to the
19 subsequent drawings starting with figure 5.

20 JUDGE LEBOVITZ: Correct.

21 MR. PAYNE: So now one of the things that really distinguishes what
22 we have here from the prior art is if you've got the hook in a position like
23 this (indicating), typically what you do when you're fishing is you see the
24 line bob and you pull on the line, and that's what hooks the fish.

25

1 Well, that won't even work here. If you -- I -- my hand is the -- well,
2 let's do it the other way. Let me do it this way. If this is the fishing line
3 (indicating), let's say the line is the line. You pull on that, it won't come
4 loose. It won't come up.

5 And the beauty of this is, when you're casting it, when it's hitting the
6 water, and you can go the other way, if you're casting it and it's hitting the
7 water, it won't fly open, either direction. It just won't fly open until you get
8 the lateral forces on both sides, and then it flies open. Very interesting
9 contraption.

10 JUDGE LEBOVITZ: Since you brought this up, the claim, if you
11 look at your figure 6, which is -- corresponds to the exhibit that you brought
12 in.

13 MR. PAYNE: Yes, sir.

14 JUDGE LEBOVITZ: And figure 6 shows the hook in the set position.
15 I think that's the terminology you used?

16 MR. PAYNE: Yes.

17 JUDGE LEBOVITZ: And that corresponds, I believe, to the second
18 state of claim 1, where you get overlap?

19 MR. PAYNE: Yes.

20 JUDGE LEBOVITZ: Well, when I look at this and then I compare it
21 to Danielson's figure, I see two crossovers in both. One crossover is at the
22 very top, which is where the coil and the very distal, distal ends of the flanks
23 cross over, and the other one is at the bottom. So I see overlap in two
24 places.

25 MR. PAYNE: Right.

1 JUDGE LEBOVITZ: And at one point you were making an argument
2 that we only have one overlap. And if I want to interpret one overlap and
3 the overlap would be here (indicating), the proximal end where the catch is,
4 but there is a crossover here (indicating), but we're going to ignore that
5 because that's really part of the spring mechanism.

6 And I would make that same argument in the -- if you have the Daniel
7 figure in front of you --

8 JUDGE MILLS: Danielson, right?

9 JUDGE LEBOVITZ: Danielson figure.

10 MR. PAYNE: Right.

11 JUDGE LEBOVITZ: It also has a crossover right where the spring or
12 the coil mechanism is?

13 MR. PAYNE: Right.

14 JUDGE LEBOVITZ: So I don't see that as distinguishing it because
15 if it -- because there's no way that you could create this from one piece and
16 not have a crossover here (indicating).

17 But I'm assuming, based on your spec and based on the drawing, that
18 this is considered part of the coil, and the crossover we're talking about is
19 right down at the very bottom where the catch is?

20 MR. PAYNE: Right, where the end of the hook is.

21 JUDGE LEBOVITZ: Right.

22 MR. PAYNE: So to speak. That's right.

23 JUDGE LEBOVITZ: Okay. Because there was an argument in the
24 brief that seemed to say, well, Danielson has two.

25

1 MR. PAYNE: Let's talk about Danielson, because I think you've
2 raised an excellent point and I think Danielson is the primary reference here.

3 So when we look -- and behind tab 4 is Danielson. And what I've
4 done is I've highlighted some parts that I wanted to talk about on Danielson
5 which addressed some issues.

6 And particularly, Danielson -- the interesting thing about Danielson is
7 not only is it not the same structure, but it really functions very, very
8 differently.

9 I mean, it isn't even close to what this invention is because if you look
10 at the figure -- and I've highlighted two little sections of Danielson there --
11 what happens is with Danielson, you push the coil part back and you hook it
12 around.

13 Behind tab 4, I've got it highlighted so you can see exactly what I'm
14 talking about. There's a projection lug 16 and also another lug, 5. And
15 when you load Danielson, you push the spring coil back up against -- which
16 is in figure 1 -- against lug 5 and you hook the -- you attach the hook part
17 around pin 7 and head 8.

18 JUDGE LEBOVITZ: Well, we understand that completely.

19 MR. PAYNE: And then when you pull it, it pulls it away.

20 JUDGE LEBOVITZ: Right. We understand that completely. But the
21 examiner's basis for the rejection seems to be that you would substitute the
22 catch of Schaefer in Danielson's hook. And you would do that for the
23 benefit described by Schaefer, and that is that you get an auto hook, which is
24 the same type as what is embodied in this hook right in front of me.

25

1 MR. PAYNE: Well, not quite. Let's talk about Schaefer, because
2 Schaefer is what I call the Cool Hand Luke reference. And I call it the Cool
3 Hand Luke reference because I truly believe there is a failure to
4 communicate here.

5 And let's look at Schaefer. And behind tab 5 there is some sections of
6 Schaefer. The interesting thing about Schaefer is Schaefer isn't a fishhook.
7 It is a hooking gaff. Schaefer has nothing to do with this going into the
8 mouth of a fish.

9 If you look at Schaefer, in column 1, it talks about contacting the fish.
10 And then shortly below, it says snaring the fish, and then it's rendered
11 ineffective by action of the fish. And then later on in column 1, it's again
12 contacting the fish to make it open.

13 And then in column 2, it's talking about the action of the fish. There's
14 not a single reference in Schaefer about the fish's mouth or the fish biting it.
15 This is not a fishhook. This is a gaff.

16 Now, what happens is it rubs up and bumps one of these, and the hook
17 unlatches. And then if you look at figure, for example, 2, one of the spines
18 comes out and jabs the fish like a gaff, which, if you look at the reference,
19 all the way through it talks about a hook or a gaff.

20 And behind tab 6 I've got the definition of a gaff. There's not a
21 mention about a fish's mouth, there's not a mention about this thing ever
22 being swallowed.

23 The way this works is in Schaefer, it bumps up the side of Schaefer,
24 and that's what unleashes or unlatches it. That's a different kind of latch

1 from what we've got here, very different kind of latch that wouldn't even
2 work in this case. It wouldn't be obvious.

3 JUDGE LEBOVITZ: But one second. I hear what you're saying, but
4 I guess, how would you -- two things. One is, column 1, it does say at line
5 65, it says, They will be retained until such time as they are contacted by a
6 fish or other object, which will impart sufficient lateral movements. So we
7 are talking about forces on the sides of the hook.

8 MR. PAYNE: Right. And the beauty there is -- is it even tells you
9 there in that very statement you read that it could hit any other object. It
10 could hit a stump, and it would stick into the side of the stump.

11 JUDGE LEBOVITZ: Okay. True. But the second issue is that claim
12 1 is just an apparatus.

13 So given the fact that this apparatus or the catch of the apparatus
14 meets all the limitations, assuming that for a minute -- and I know you have
15 arguments -- it doesn't matter whether these guys teach it for requiring that
16 you bump up against it or, in fact, if you had a big enough fish or the hook
17 was small enough -- I'm sure it could swallow it, and you'd get lateral
18 movement, and it would open in the guy's mouth.

19 MR. PAYNE: Right. But let me say the way Schaefer works is if it
20 bumps either side of Schaefer, it opens. It's got to work that way because of
21 the way it's described, either side.

22 If you do either side of this one, it won't open. It's not the same latch.
23 It couldn't be the same latch. You've got to have forces on both sides of this
24 to open.

1 Now, let me also say, to show you that Schaefer is not a hook like
2 we're talking about, let's go fishing, literally. Let's look at figure 2 of
3 Schaefer. And let's say that the fish has swallowed figure 2 of Schaefer and
4 the arms are in its mouth and they're open.

5 And you want -- and you're the fisherman, and you want to pull that
6 out of the water. So when I pull on Schaefer, in that sense, if I'm pulling this
7 way (indicating), all that's going to happen is those springs are going to
8 spring closed and it comes right out of his mouth. The barbs are the wrong
9 way. It doesn't work. It's not functional for what this hook does.

10 And the latch is a completely different kind of latch because it's
11 displaced by hitting on one side, not both sides.

12 JUDGE LEBOVITZ: Okay. I understand that. But again, it appears
13 that the examiner is saying you could use that latch mechanism in Daniels'
14 hook, so you get the advantage of an automatically opening hook, and you
15 don't have to rely on the jerking motion to open it.

16 MR. PAYNE: For sure, you don't have to rely on the jerking motion.
17 But my point is that you can't substitute that latch because that latch would
18 make this device inoperable if you could open it by pushing on just one side.
19 It doesn't work that way. And that's why we limited the claims to having
20 forces on both sides, because the latch in Schaefer just isn't the same latch.

21 JUDGE LEBOVITZ: How did the examiner respond to that?

22 MR. PAYNE: Okay. Let's look. That's a very good question.
23 You've got a lot of good questions. I thought I was going to be doing all the
24 talking here.

25 JUDGE LEBOVITZ: I'm a fisherman.

1 MR. PAYNE: Okay.

2 JUDGE LEBOVITZ: No, just joking. That's a joke.

3 MR. PAYNE: Well, now I understand.

4 JUDGE LEBOVITZ: That's a joke.

5 MR. PAYNE: Okay. Let's look in tab 8 is the examiner's answer.

6 And the relevant part starts at the bottom of page 3 and goes over to page 4.

7 And in that the examiner says Schaefer discusses how the trap hook
8 functions in column 1, line 65. And he says, No mention is made of any
9 pulling force exerted by the fish.

10 He's absolutely correct. I agree 100 percent, because the fish isn't
11 going to pull because it's not going to go in his mouth. That's not what it's
12 meant to do.

13 Then he says, But that a lateral force exerted to the hooks to disengage
14 the interlocking means is effected by the fish. Again, I agree with the
15 examiner 100 percent. There is a lateral force, not lateral forces on both
16 sides, and it is affected or effected by the fish because the fish isn't biting it
17 because it's not a hook-type device, it's a gaff-type device.

18 But here's where we go awry between myself and the examiner, as the
19 very next sentence says, When a fish bites, the main force is exerted by the
20 jaws closing, which is the two opposing forces of the jaws being closed on
21 the prey by the fish.

22 That can't be Schaefer. It doesn't even work that way. It doesn't need
23 two forces. And indeed, it teaches away from two forces. There's no way to
24 combine Schaefer with Danielson because it just functions differently.

1 And then the examiner goes on to say -- I mean, it's not the same
2 structure, it's not the same function, it's just completely different and would
3 make the present invention inoperable if you were to apply it to that.

4 Then the examiner goes on to say, So the device of Schaefer and
5 Danielson would also inherently experience those forces as the fish strikes
6 the bait.

7 Well, we know already in Danielson that the fish biting the bait
8 doesn't release anything. It's when you pull the string and you disengage the
9 coils from position A to position B that releases that.

10 And in Schaefer, we know that Schaefer is really a gaff-type device
11 and the force on one side releases it. And as a matter of fact, interestingly,
12 in Schaefer, behind tab 5 -- I'm sorry. Go ahead.

13 JUDGE LEBOVITZ: Where do you see clearly that this does not
14 operate by the mechanism in the wherein clause of the two generally
15 opposing forces or independent -- so two generally opposing forces?

16 When I look at column 1, line 65 to 67 or 8, it just says that, Until
17 such time as they, meaning the hooks, are contacted by a fish or other object
18 which will impart sufficient lateral movements to the hooks or one of the
19 hooks to disengage. So it seems to say that both can disengage it.

20 MR. PAYNE: Well, what's most important is in our case, one side
21 will not engage it. It takes both sides. Yet the most important --

22 JUDGE PRATS: Okay. Correct. If I may, though, your whereby
23 clause says, Further, whereby upon the application of two generally
24 opposing forces applied about said first shank and said second shank -- this
25 is from claim 1.

1 Does't your claim read on -- wouldn't, if you apply two forces on
2 Schaefer's -- on each side of Schaefer's hook catch, wouldn't that have it
3 open just as recited in your claim?

4 MR. PAYNE: That's right. And if it did, it wouldn't catch anything.
5 But the important thing is that latch cannot be this latch because if it were
6 this latch, that couldn't happen, what you just said.

7 JUDGE PRATS: And I think what I'm saying is that this functional
8 limitation -- why isn't this functional limitation met by Schaefer?

9 MR. PAYNE: Well, I think that this functional limitation is not met
10 by Schaefer because the latch in Schaefer requires only that one side -- I
11 mean, one side be engaged to disengage it.

12 This latch, you can't -- I mean, this hook, it won't even engage, so that
13 can't be a structure that could be substituted because it wouldn't work. It
14 would make this invention inoperable.

15 JUDGE PRATS: So you're saying if you applied two generally
16 opposing forces to the catch of Schaefer, that would not open the fishhook?

17 MR. PAYNE: No. I think that would open the fishhook.

18 JUDGE PRATS: Well, then we go back to my question as to why
19 doesn't Schaefer meet the functional limitation. I understand you're saying
20 that Schaefer can be opened by only one force. But it also appears that
21 Schaefer can be opened by two generally opposing forces exactly as recited
22 in your claim. That's kind of what's bugging me about this argument.

23 MR. PAYNE: Okay. Right. So if you look at that claim, though,
24 we've got two aspects, the functional aspect and we've got the structural

1 aspect. And the structural aspect is very specific of how this -- what this
2 latch is. It is very specific as to what this latch is.

3 And the structural language clearly distinguishes over anything that
4 Schaefer could be, even though I think Schaefer is not explicit as to what it
5 is. But it cannot be this. And that structural language is clearly in there
6 verbatim, where it says -- if you look at claim 1, it's talking about first shank,
7 second shank.

8 And let me also say that the thing that's really important, I think, out
9 of everything that makes this invention different from both of these guys is
10 the fact that this is a single piece of wire, and we've limited it to that.

11 Schaefer could not work with a single piece of wire. There's no way.
12 So not only do we have the fact that it's a single piece of wire, but we have a
13 fact that there's a tensioner for the first shank, and a catch integral to said
14 first shank comprising an offset disposed about the first shank.

15 That kind of real clear language clearly distinguishes over Schaefer.
16 And in light of that functional language that we have in the claim, in my
17 mind makes Schaefer inapplicable to combine that latch with Donaldson
18 [sic]. I mean, the fact that it's a single piece of wire and that the latch
19 structurally is defined in the claim.

20 Now, I will tell you this. I agree with you 100 percent; if the latch
21 were not structurally defined in the claim, then I would be on your team. I
22 would say, hey, there's a big problem here; we need to go back and --

23 JUDGE LEBOVITZ: Where do you see the latch being structurally
24 defined?

1 MR. PAYNE: Well, I think in the fourth limitation where it says, A
2 catch, which is the latch, integral to said first shank, and then we're talking
3 about the catch or latch comprising an offset disposed about the first shank
4 and releasably in communication with the second shaft.

5 So what we've got is, if you look at one of these little guys, we've got
6 this offset portion, which clearly is not in Schaefer, which is a structural
7 distinction.

8 JUDGE LEBOVITZ: Well, one sec. If we look at Schaefer, the
9 drawing of Schaefer, I see the hook part where the latch is for the
10 interlocking means as being off the straight curved part of the flank. And I
11 interpret "offset" to mean displaced from a straight line or, in this case, a
12 curved line.

13 So that little bend, the 90-degree bend to me would be an offset
14 because all the claim does is saying offset disposed about first shank. And
15 this little piece here labeled 6 in Schaefer is offset to the extent that it
16 deviates from the straight line formed by the proximal or distal portion of the
17 shaft.

18 MR. PAYNE: Right. And I agree. And like I said to Examiner [sic]
19 Prats is I think that if we didn't have both, we would be in trouble here.

20 But I think the fact that we have the offset being the way it works and
21 the functional language that it requires an offset in relationship to the two
22 ends and -- uh-oh. That's what I was talking about. That's why we need to
23 be very careful with these.

24 The functional language along with the structural language clearly
25 distinguishes Schaefer's latch from the latch mode of the present invention.

1 So one or the other doesn't, but I think together, they certainly distinguish
2 over Schaefer, and especially when you try to put Schaefer into Danielson.

3 I mean, they don't even -- none of them work together, and none of
4 them are one single piece of wire comprising all of the elements.

5 JUDGE MILLS: Don't you have comprising claim language which
6 would allow other elements in addition to the single piece of wire?

7 MR. PAYNE: Well, not really. The way I read this claim is we say
8 in the preamble, we start with the improved hook apparatus formed from a
9 single piece of wire before the comprising, and then we go down and use
10 that later.

11 So the single piece of wire, we're stuck with. I don't think that we get
12 to add things to our single piece of wire, nor did we intend it to be that way,
13 and that was the reason that we claimed it in the preamble and in the --

14 JUDGE LEBOVITZ: As a single wire and also a catch integral to
15 said first shank, you're saying means that it's part of a wire?

16 MR. PAYNE: Absolutely. Absolutely, as illustrated in the drawings
17 and described in the specification, which is not true with respect to either of
18 the two cited references.

19 JUDGE MILLS: It does look like we're running out of time. Is there
20 any summary you'd like to make?

21 MR. PAYNE: Well, other than I think that I will say you guys really
22 did your homework well. And it's good to have a fellow fisherman on the
23 panel.

24 In summary, I think it's clear that Donaldson [sic, Danielson] requires
25 a pull which moves the coil that's inside, so it's very different.

1 And the latch of Schaefer, Schaefer not even being really a hook, that
2 could be disengaged by one side or both sides in conjunction with the
3 structural limitations and functional limitations I think distinguishes the two
4 references from what we have in this invention.

5 And then the last thing I think is the fact that, you know, it is a single
6 piece of wire, and we claimed it in the preamble and in the limitations, and
7 therefore, we're stuck with it.

8 JUDGE MILLS: Okay. I think we understand your position. Thank
9 you very much.

10 JUDGE LEBOVITZ: I just want to put something on the record, and
11 that is this. I am not a fisherman. I don't have any special interest in this.

12 MR. PAYNE: And you know what, neither am I.

13 (Whereupon, the proceedings at 1:34 p.m. were concluded.)
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